

REMARKS/ARGUMENTS

Reconsideration and withdrawal of the rejection of the application are respectfully requested in view of the amendments and remarks herein, which place the application into condition for allowance.

I. STATUS OF THE CLAIMS AND FORMAL MATTERS

Claims 1-19 and 21-22 are currently pending. Claims 1, 3-5, 10, 13, 16, and 21-22, which are independent, are hereby amended. Support for this amendment is provided throughout the Specification as originally filed, and, for example, in the Published Application pars. [0003]-[0004].

No new matter has been introduced by this amendment. Changes to the claims are not made for the purpose of patentability within the meaning of 35 U.S.C. §101, §102, §103, or §112. Rather, these changes are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. REJECTIONS UNDER 35 U.S.C. 103

Claims 1-4, 16-19, 21 and 22 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent Application Publication No. 2002/0046407 to Franco (hereinafter, merely “Franco”) in view of U.S. Patent No. 6,536,041 to Knudsen (hereinafter, merely “Knudsen”) and further in view of U.S. Patent No. 6,588,015 to Eyer et al. (hereinafter, merely “Eyer”) and Official Notice;

Claims 5-15 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Franco, Knudsen and Eyer and further in view of U.S. Patent No. 6,704,929 to Ozer et al. (hereinafter, merely “Ozer”) and also under Official Notice.

Applicants respectfully traverse these rejections.

Claim 1 is representative and recites, *inter alia*:

“ . . . receiving means for receiving said preset-recording data, keyword data, and first advertisement-associated data from said information providing apparatus in response to said television program identifying information and second advertisement-associated data from said information providing apparatus in response to said keyword data;

. . .
 . . . force the display of said first and second advertisement-associated data substantially at the same time to force a viewer to playback said first and second advertisement-associated data while simultaneously playing back said television program.” (Emphases added)

Applicants respectfully submit the combination of Franco, Knudsen, Eyer and Ozer does not teach the above-recited feature of claim 1. In particular, in an aspect of the present invention, two advertisements are received in response to transmitting a request for the preset-recording data. A first advertisement is responsive to program identifying information. A second advertisement is responsive to the keyword data. Moreover, both the first a second advertisements are displayed at the same time while the television program is also being played back.

In an example from the specification, a program to be recorded is identified by the recording date and channel data received. The advertisement site sends the first advertisement-associated data supplied by a sponsor who purchased the corresponding advertisement frame on the television program based on the recording date/time and channel data. Publ. App. pars. [0150]-[0152] and FIG. 19.

Also, the advertisement site matches the program keyword to a second advertisement based upon a relationship managed by the advertisement site. Publ. App. par. [0156] and FIG. 22.

By executing the above-mentioned advertisement-associated data acquisition processing, the first advertisement is related to the program date/time/channel purchased by the sponsor of the program. The second advertisement is related to the keyword associated with the program.

Both the first and second advertisements are displayed at the same time on the screen along with the television program. Publ. App. par. [0163] and FIG. 23.

The above-described feature is not describe in the combination of Franco, Knudsen, Eyer and Ozer.

For reasons similar, or somewhat similar, to those described above with regard to independent claim 1, independent claims 3-5, 10, 13, 16, and 21-22 are also patentable.

III. REJECTIONS OF CLAIMS UNDER OFFICIAL NOTICE

Claims 6-7, 11-12, 14-15 and 17-18 were rejected under Official Notice.

Claims 6-7, 11-12, 14-15 and 17-18 depend from one of the independent claims discussed herein above and are believed patentable for at least the same reasons.

Moreover, Applicants contend the Office Action impermissibly relies on Official Notice and fails to respond to Applicants' challenge under MPEP 2144.03(C).

APPLICANTS CHALLENGE THE FACTUAL ASSERTIONS AS NOT PROPERLY OFFICIALLY NOTICED OR NOT PROPERLY BASED UPON COMMON KNOWLEDGE.

- In Applicants' January 25, 2007 reply to the Office Action mailed October 20, 2006, Applicants challenged the factual assertions of the Official Notice taken. The next Office Action mailed April 19, 2007 failed to address Applicants' challenge.

- In Applicants' July 18, 2007 reply to the Office Action mailed April 19, 2007 Applicants again challenged the factual assertions of the Official Notice taken. The present Office Action also fails to address Applicants' challenge.

The present Office Action again relies on Official Notice in order to reject claims 18-19 (see page 11) and claims 6-7, 11-12, and 14-15 (see page 16). Applicants respectfully traverse this rejection.

From the MPEP 2144.03(E): "Any rejection based on assertions that a fact is well-known or is common knowledge in the art without documentary evidence to support the examiner's conclusion should be judiciously applied. Furthermore, as noted by the court in *Ahlert*, any facts so noticed should be of notorious character and serve only to 'fill in the gaps' in an insubstantial manner which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection. *See, for example, In re Zurko*, 258 F.3d 1379, 1386; *In re Ahlert*, 424 F.2d 1088, 1092."

Further, "[a]s noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be 'capable of such instant and unquestionable demonstration as to defy dispute.' (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961))." MPEP 2144.03 (emphasis added).

Claim 18 is representative and recites, *inter alia*:

"... said acquiring means acquires a keyword preset to said television program from a second site and second advertisement-associated data corresponding to said keyword from said first site."

The Office Action asserts at page 11, "Official Notice is taken that it is well known in the art to acquire program information (such as keywords defining the type of program) so as to

reduce traffic on any one site . . .” Applicants respectfully point out that that is **not what is recited in claim 18.**

Claim 18 depends from claim 17. Claim 17 recites, *inter alia*, “acquires first advertisement-associated data preset to said television program corresponding to said television program identifying information from a first site.” Applicants do not concede claim 17 is well-known in the art. However, claim 18 adds the additional limitation as recited above. Thus, the combination of elements recited in claims 17 and 18 require, in relevant part, acquiring from a first website the first advertisement-associated data corresponding to the television program **AND** acquiring from a second website a keyword preset to the television program **AND ALSO** acquiring from the first website second advertisement-associated data corresponding to the keyword (that was acquired from the second website).

Moreover, the second website (the keyword site) is defined in the specification. *See, for example*, Publ. App. par [0150].

“The keyword site herein denotes is a site on the network 6 which identifies a program to be recorded on the basis of the recording date and channel data received from the iEPG site 7 and transmits a program keyword (to be described with reference to FIG. 21) recorded as related to the identified program to the iEPG site and the advertisement site 8.”

The Office Action also must use Applicants’ definition of the second website when asserting Official Notice. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1319 (Fed. Cir. 2004) (“Claims are construed in light of the specification, of which they are a part”). *See, also*, MPEP 2101.01 and MPEP 2173.05. Thus, any Official Notice or alleged prior art **must** identify a second site as defined in Applicants’ specification.

Applicants contend the Office Action depends on a mere conclusory statement and an impermissible reliance on Official Notice. The Applicants contend the features of claim 18 are not of notorious character nor insubstantial, as asserted in the Office Action. Certainly, the

features recited in claim 18 are not capable of “instant and unquestionable demonstration as to defy dispute.” These features are neither “basic knowledge” nor “common sense.” In re Lee, 277 F.3d 1338, 1345 (Fed. Cir. 2002) (“Deficiencies of the cited references cannot be remedied by the Board's general conclusions about what is ‘basic knowledge’ or ‘common sense.’”). Applicants contend that claim 18 recites substantive features that can not be overcome with Official Notice.

Thus, in accordance with MPEP 2144.03(C) and so that the record of prosecution be complete, Applicants respectfully request documentary evidence under 37 C.F.R. 104(c)(2) of the elements recited in claim 18, or an affidavit of the Examiner under 37 C.F.R. 104(d)(2) setting forth specific factual statements and explanation to support the facts asserted.

IV. DEPENDENT CLAIMS

The other claims are each dependent from one of the independent claims discussed above, and are therefore patentable for at least the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

CONCLUSION

All claims are in condition for allowance. In the event the Examiner disagrees with any of statements appearing above with respect to the disclosure in the cited reference(s), it is respectfully requested that the Examiner specifically indicate those portion(s) of the reference(s), providing the basis for a contrary view.

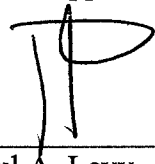
Please charge any additional fees that may be needed, and credit any overpayment, to our Deposit Account No. 50-0320.

In view of the foregoing amendments and remarks, it is believed that all of the claims in this application are patentable and Applicants respectfully request early passage to issue of the present application.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP
Attorneys for Applicants

By: _____


Paul A. Levy
Reg. No. 45,748
(212) 588-0800